

REMARKS

The Amendments

The claims are amended to direct them to the subject matter indicated to have been searched in the Office action.

The amendments were made due to restriction of the claims not for reasons related to patentability. The amendments should not be interpreted as acquiescence to any objection or rejection made in this application.

Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

The Indicated Allowable Subject Matter and Restriction Requirement

The Office action appears to be indicating that the subject matter which was searched, i.e., where R¹ is an optionally substituted thienyl or furyl group, is allowable. No rejections are made in the Office action. However, the Office action indicates that the search will not be extended to the further scope of the genus claimed.

Applicants understand from this that the further subject matter is being restricted, since this would be the only basis for refusing to search the whole claimed scope. Although applicants do not believe a proper basis for restriction has been established, in the interests of furthering the prosecution here, the scope of the claims has been narrowed to the searched subject matter pursuant to the restriction requirement. Thus, the claims are believed to be directed to subject

matter indicated as being allowable.

Request for Rejoinder

As to the restriction between the compounds and preparation processes, reference is made to the decisions in In re Ochiai, 37 USPQ2d 1127 (Fed. Cir. 1995), and In re Brouwer, 37 USPQ2d 1663 (Fed. Cir. 1996). The Commissioner's comments thereon in 1184 TMOG 86, March 26, 1996, indicate that, where product and process claims in the same application have been restricted and the elected product claim has been found allowable, withdrawn process claims including the limitations of the allowed product claim will be rejoined into the application and fully examined in that same application. If the compounds are novel and nonobvious, it logically follows that the method for making those compounds would be novel and nonobvious, i.e., if the compounds are not known or suggested, there is no motivation to provide a method for making them. It would appear that the product claims are now allowable. Therefore, the process claims, which are amended to require the particulars of the allowable product claims, should be rejoined for allowance therewith.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

/John A. Sopp/
John A. Sopp, Reg. No. 33,103
Attorney/Agent for Applicant(s)

MILLEN, WHITE, ZELANO
& BRANIGAN, P.C.
Arlington Courthouse Plaza 1, Suite 1400
2200 Clarendon Boulevard
Arlington, Virginia 22201
Telephone: (703) 243-6333
Facsimile: (703) 243-6410

Attorney Docket No.: MERCK-2979

Date: October 22, 2008
JAS:sb